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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN S. HOMER

Appeal 2009-003060
Application 10/826,046
Technology Center 2800

Decided: September 15, 2009

Before EDWARD C. KIMLIN, BRADLEY R. GARRIS, and
ADRIENE LEPIANE HANLON, *Administrative Patent Judges*.

HANLON, *Administrative Patent Judge*.

DECISION ON APPEAL

A. STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134 from an Examiner's decision rejecting claims 1-8, 11-19, and 35-40.¹

¹ Claims 9, 10, 20-26, and 28-34 are also pending. Claims 22-26 and 28-34 have been allowed by the Examiner, and claims 9, 10, 20, and 21 have been

We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A portable computer system, comprising:
a bezel having a bezel flange contacting and supporting a screen; and
an antenna disposed at least partially between the bezel flange and a portion of the screen.

Br. 15, Claims Appendix.²

The following Examiner's rejections are before us on appeal:

- (1) Claims 35 and 40 are rejected under 35 U.S.C. § 101 as claiming the same invention as claim 34 of Application 10/235,359.³
- (2) Claims 1, 3, 5-8, 11-13, and 15 are rejected under 35 U.S.C. § 102(b) as anticipated by Shin.⁴
- (3) Claims 35-40 are rejected under 35 U.S.C. § 102(b) as anticipated by Detwiler.⁵
- (4) Claims 2, 4, 14, and 16-19 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Shin and Detwiler.

B. ISSUES

- (1) Has the Appellant identified reversible error in the Examiner's determination that claims 35 and 40 claim the same invention as claim 34 of Application 10/235,359?

objected to as being dependent upon a rejected base claim. *See* Final Office Action dated April 11, 2007, at 10-11.

² Appeal Brief dated August 16, 2007.

³ Application 10/235,359 issued on November 27, 2007, as US 7,301,783.

⁴ US 2002/0151328 A1 to Shin published October 17, 2002.

⁵ US 2002/0100805 A1 to Detwiler published August 1, 2002.

(2) Has the Appellant identified reversible error in the Examiner's determination that Shin and Detwiler, either alone or in combination, describe or suggest the subject matter of claims 1, 11, 16, 35, and 38?

C. DISCUSSION

1. Issue (1)

a. Findings of fact

Claims 35 and 40 of the instant Application read as follows:

35. A portable computer system, comprising:
a screen; and
an antenna formed on the screen.
40. The system of Claim 35, wherein the screen comprises a transparent screen.

Br. 16-17, Claims Appendix.

Claims 1 and 34 of Application 10/235,359 read as follows:

1. A system for promoting wireless communication, comprising:

a portable computer having a plastic housing, a transparent display screen panel mounted in the plastic housing in front of a display module, wherein the transparent display screen panel comprises an antenna oriented in a position unobstructed by the plastic housing and the display module.
34. The system recited in claim 1, wherein the antenna is mounted on and behind the transparent display screen panel.

Br. 18, Evidence Appendix.

b. Principles of law

Section 101 of Title 35 of the United States Code prevents two patents from issuing on the “same invention.” The phrase “same invention” means identical subject matter. *In re Vogel*, 422 F.2d 438, 441 (CCPA 1970).

c. Analysis

The Appellant argues that claims 35 and 40 of the instant Application do not claim the “same invention” as claim 34 of Application 10/235,359 (“the 359 Application”). For example, the Appellant argues that “[c]laim 35 of the instant application recites ‘an antenna formed on the screen,’ while claim 34 of the ‘359 Application recites an antenna ‘disposed on and behind the transparent display screen panel.’” Br. 6.

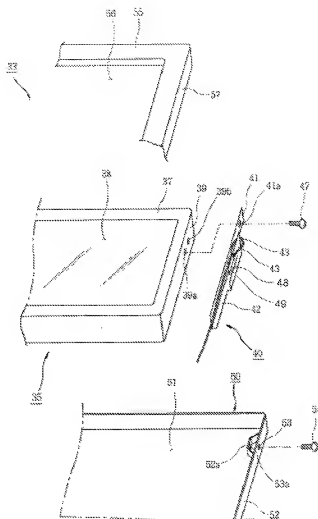
The Appellant’s argument is persuasive of reversible error. An antenna “formed *on* the screen” as recited in claim 35⁶ of the instant Application is not identical to an antenna “mounted *on and behind*” the screen as recited in claim 34 of the 359 Application. Br 16, 18 (emphasis added). Thus, we conclude that claims 35 and 40 of the instant Application do not claim the “same invention” under §101 as claim 34 of the 359 Application.

2. Issue (2)

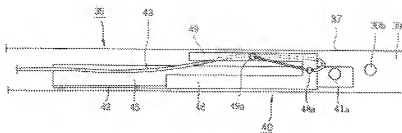
a. Findings of fact

Figures 2 and 4 of Shin, reproduced below, illustrate an internal antenna for a mobile electronic device.

⁶ Claim 40 of the instant application depends from claim 35. Br. 17.

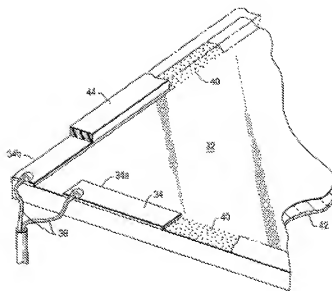


Shin Figure 2 depicts an exploded view of a portion of an electronic device comprising an upper case 55, a display unit 35, and a lower case 50.



Shin Figure 4 depicts an antenna 40 fixed to a side wall 39 of the display unit 35.

Figure 4 of Detwiler, reproduced below, illustrates an antenna loop disposed on a screen.



Detwiler Figure 4 depicts an antenna 34 deposited on a screen 32 via an adhesive 40.

We adopt the Examiner's findings of fact set forth on pages 4-9 of the Final Office Action dated April 11, 2007, and pages 4-9 of the Examiner's Answer dated November 14, 2007 ("Ans.").

b. Principles of law

During patent examination, the pending claims must be interpreted as broadly as their terms reasonably allow. *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989).

c. Analysis

The Appellant does not contest the Examiner's findings of fact or conclusions of law. The Appellant merely contends that the prior art does not describe or suggest various limitations of the claims on appeal.

1. Claim 1⁷

The Appellant argues that Shin does not disclose “a bezel having a bezel flange contacting and supporting a screen” as recited in claim 1. Br. 7.

The Examiner interprets claim 1 as reciting that a bezel, rather than a bezel flange, contacts and supports a screen. The Examiner found that the bezel 55 of Shin contacts and supports the screen 38 when the disclosed electronic device is assembled. Ans. 12.

The Appellant also argues that Shin does not disclose “an antenna disposed at least partially between the bezel flange and a portion of the screen” as recited in claim 1. Br. 7-8.

The Examiner found that the screen 38 of Shin is slightly recessed in the display unit 35 and below the frame 37. Thus, the Examiner found that when the electronic device of Shin is assembled, the antenna 40 is disposed between the bezel flange 57 and the recessed portion of the screen 38. Ans. 13.

⁷ The Appellant does not address the patentability of claims 3, and 5-8 separately from the patentability of claim 1.

The Appellant has failed to direct us to any error in the Examiner's interpretation of claim 1 or the Examiner's findings of fact.

2. Claim 11⁸

The Appellant argues that Shin does not disclose a “means for contacting and supporting a screen” as recited in claim 11. Br. 8-9.

However, the Examiner found that Shin does disclose “a means [50, 55] for contacting and supporting a screen [38].” Ans. 5. The Examiner directs our attention to paragraph [0064] of Shin which reads as follows:

The upper case 55 is formed in a square-rim shape, and a side wall 57 thereof is fixed to the lower case 50 in a manner of surrounding the display unit 35 to *support* the display unit 35, and an opening portion 56 is formed in the upper case 55 to expose a display panel 38 of the display unit 35. [Emphasis added.]

Ans. 13-14.

Based on this disclosure in Shin, it is reasonable to find that at least the upper case 55, which includes side wall 57, contacts and supports the display unit 35, including the screen 38. Ans. 13-14. Thus, it is reasonable to find that the upper case 55, including side wall 57, corresponds to the “means for contacting and supporting a screen” recited in claim 11.

The Appellant also argues that Shin does not disclose “antenna means disposed at least partially between the contacting and supporting means and an interior surface of the screen” as recited in claim 11. Br. 9.

The Examiner found that the edge of the screen 38 which is internal and parallel to the side wall 39 corresponds to the “interior surface of the screen” recited in claim 11. Thus, the Examiner found that when the

⁸ The Appellant does not address the patentability of claims 12, 13, and 15 separately from the patentability of claim 11.

electronic device of Shin is assembled, the antenna 40 is disposed between the means for contacting and supporting a screen (55, 57) and an interior surface of the screen 38. Ans. 14.

Again, the Appellant has failed to direct us to any error in the Examiner's findings.

3. Claims 35 and 38⁹

The Appellant argues that Detwiler does not disclose “an antenna formed on the screen” as recited in claim 35 or an antenna comprising “at least one conductive trace deposited onto a surface of the screen” as recited in claim 38. Instead, the Appellant argues that Detwiler discloses an antenna 34 in the form of a copper foil ribbon that is applied to a window 32 using an adhesive 40. Br. 10-11.

The Examiner explains that the limitation “formed on” in claim 35 is a product by process limitation that is given little patentable weight. *See In re Thorpe*, 777 F.2d 695, 697 (Fed. Cir. 1985) (“The patentability of a product does not depend on its method of production.”); Ans. 15.

Furthermore, referring to paragraph [0010] of the Appellant's Specification, the Examiner found that the terms “depositing” and “forming” are synonymous. Thus, the Examiner found that the antenna 34 of Detwiler, which is deposited on the screen 32 via an adhesive 40, is likewise formed on the screen. Ans. 15. Significantly, the Appellant has failed to direct us to any definition of the term “formed” in the Specification that excludes depositing or otherwise applying an antenna on a screen via an adhesive as described in Detwiler.

⁹ The Appellant does not address the patentability of claims 36, 37, 39, and 40 separately from the patentability of claims 35 and 38.

As to claim 38, the Examiner found that the antenna 34 of Detwiler is a copper foil ribbon, and thus is a conductive trace. Detwiler, para. [0033]; Ans. 15. The Appellant has failed to direct us to any definition of “conductive trace” in the Specification that excludes the copper foil ribbon described in Detwiler.

4. Claim 16¹⁰

Claim 16 recites:

16. A method of manufacturing a portable computer system, comprising:

providing a screen having an antenna *disposed on an interior surface* thereof; and

providing a bezel having a bezel flange adapted to support the screen, *at least a portion of the antenna disposed between the bezel flange and the screen.*

Br. 16, Claims Appendix (emphasis added).

The Examiner found that Shin discloses that at least a portion of an antenna (cable 43) is disposed between the bezel flange 57 and the screen 38. However, Shin does not disclose disposing any portion of the antenna 40 on an interior surface of the screen. The Examiner relies on the teachings of Detwiler to establish that it would have been obvious to dispose an antenna, such as the copper foil ribbon 34, on an interior surface of the screen. Ans. 8.

The Appellant argues that moving the antenna 43 of Shin to the interior surface of the screen 38 would result in the antenna 43 no longer being located between the bezel flange 57 and the screen 38. Br. 13.

¹⁰The Appellant does not address the patentability of claims 2, 4, 14, and 17-19 separately from the patentability of claim 16.

The Examiner explains:

[S]ince the conductive trace (34) of Detwiler would be placed on an interior surface of the screen (38) of Shin, the antenna portion (43) of Shin would still remain adjacent the exterior side wall (39) of the display (35) as a means of routing the signal received by the trace to the computing components and therefore, when the display (35) is assembled into the lower housing (50) and the bezel (55) and bezel flange (57) are lowered onto the display (35) the antenna portion (43) would remain sandwiched between the bezel flange (57) and the screen (38).

Ans. 16-17. The Appellant has failed to direct us to any error in the Examiner's position.

Finally, the Appellant argues that Shin does not disclose "providing a bezel having a bezel flange adapted to support the screen" as recited in claim 16. Br. 12. However, as discussed above, Shin discloses that the side wall or bezel flange 57 supports the display unit 35, including the screen 38. Shin, para. [0064]; Ans. 16. The Appellant has failed to explain why this disclosure in Shin does not establish that the bezel flange 57, in conjunction with bezel 55, is adapted to support the screen 38.

D. CONCLUSIONS OF LAW

The Appellant has identified reversible error in the Examiner's determination that claims 35 and 40 claim the same invention as claim 34 of Application 10/235,359.

The Appellant has not identified reversible error in the Examiner's determination that Shin and Detwiler, either alone or in combination, describe or suggest the subject matter of claims 1, 11, 16, 35, and 38.

E. DECISION

The decision of the Examiner is affirmed.

Appeal 2009-003060
Application 10/826,046

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

psb

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